

08/13/007


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| SERIAL NUMBER | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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EXAMINER

ART UNIT

PAPER NUMBER

4

DATE MAILED:

 This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 9/12/96 ☐ This action is made final.

 A shortened statutory period for response to this action is set to expire 3 month(s), X days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133
Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION
 1. ☒ Claims 13-27 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

 2. ☒ Claims 1-12 have been cancelled.

 3. ☐ Claims _____ are allowed.

 4. ☒ Claims 13-27 are rejected.

 5. ☐ Claims _____ are objected to.

 6. ☐ Claims _____ are subject to restriction or election requirement.

 7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

 8. ☐ Formal drawings are required in response to this Office action.

 9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

 10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

 11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

 12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

 13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

 14. ☐ Other
EXAMINER'S ACTION

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1. The present application Serial No. 08/713,007 filed 9/12/96 is a continuation (filed under Rule 60) of Serial No. 08/438,892.

This Office action is responsive to the preliminary amendment filed 9/12/96. As directed by the preliminary amendment, claims 1-12 were canceled, new claims 13-27 were added. Thus, claims 13-27 are presently pending in this application.

2. Claims 14-24, 27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 25, 27, "said vendor-type information" lacks clear antecedent basis.

Claims 14-24 are vague and indefinite for depending on canceled claim 1.

Claim 14 is vague and indefinite as to which station (a-c) comprises the encryption encoder and decryption decoder.

3. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in

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the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 13-27 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-5, 8-10, 12 of copending Application No. 08/438,892. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application

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are claiming common subject matter, as follows: a videophone interactive mailbox facility system.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. In view of the 35 U.S.C. § 112, second problems, claims 14-24 are presumed to depend on claim 13 in the following rejections.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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7. Claims 13, 15, 16, 19-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Kenney (US PAT. 5,515,424 filed 12/13/93).

In Kenney, videophone 16 correlates to the claimed user station, 14 correlates to the claimed central data center (note col. 6 lines 48-62 for example), subscriber 81 is the vendor.

8. Claims 13, 15, 16, 19-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Wert (US PAT. 5,528,672 filed 12/29/93).

In Wert, videophone 12 correlates to the claimed user station, 24 correlates to the claimed central data center (note col. 6 lines 48-62 for example), subscriber 60 is the vendor.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenney in view of Gattis et al (US PAT. 5,062,136 hereinafter Gattis).

Kenney differs from the claimed invention in not disclosing the encryption encoder and decryption decoder.

However, it is old and well known in the art to provide encryption encoder and decryption decoder to prevent unauthorized access to transmitted information, for example see Gattis Figs. 1-2; col. 3 lines 40-44 for example. Thus, it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to modify Kenney to include an encryption encoder and decryption decoder to prevent unauthorized access to transmitted information.

11. Claims 17, 18 are rejected under 35 U.S.C. § 103 as being unpatentable over Kenney in view of Davis et al (US PAT. 5,365,577 hereinafter Davis) and Kadowaki (US PAT. 5,448,285).

Kenney differs from claim 17 in not disclosing the videophone comprises a memory chip for storing information, a touch pad and printer (claim 3).

Davis discloses a videophone (Fig. 10) for communications with a database. Davis also teaches the videophone includes a memory chip for storing received information, for example see col. 11 lines 14-16, 54-68; col. 12 lines 47-55. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kenney to include a memory chip for storing received information such that the user can retain the received information for future reference or the like.

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The obvious combination of Kenney and Davis differs from claim 17 in not disclosing the videophone further comprises a touch pad. However, it old and well known in the art for a videophone to comprise a touch pad (and pointer--i.e. finger, or stylus as is well known in the art) as the input means, for example see Kadowaki. Thus, it would have been further obvious to one of ordinary skill in the art at the time the invention was made to modify the device of the obvious combination of Kenney and Davis to comprise a touch pad as the input means since the touch pad is more versatile and provides more information selection input than the standard keypad.

Regarding claim 18, Davis also teaches to provide a printer to the videophone for a hardcopy printout of the transaction, see Davis col. 15 lines 27-45.

12. Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wert in view of Gattis et al (US PAT. 5,062,136 hereinafter Gattis).

Wert differs from the claimed invention in not disclosing the encryption encoder and decryption decoder.

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However, it is old and well known in the art to provide encryption encoder and decryption decoder to prevent unauthorized access to transmitted information, for example see Gattis Figs. 1-2; col. 3 lines 40-44 for example. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wert to include an encryption encoder and decryption decoder to prevent unauthorized access to transmitted information.

13. Claims 17, 18 are rejected under 35 U.S.C. § 103 as being unpatentable over Wert in view of Davis et al (US PAT. 5,365,577 hereinafter Davis) and Kadowaki (US PAT. 5,448,285).

Wert differs from claim 17 in not disclosing the videophone comprises a memory chip for storing information, a touch pad and printer (claim 3).

Davis discloses a videophone (Fig. 10) for communications with a database. Davis also teaches the videophone includes a memory chip for storing received information, for example see col. 11 lines 14-16, 54-68; col. 12 lines 47-55. Thus, it would have been obvious to one of ordinary skill in the art at the time the

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The obvious combination of Wert and Davis differs from claim 17 in not disclosing the videophone further comprises a touch pad. However, it old and well known in the art for a videophone to comprise a touch pad (and pointer--i.e. finger, or stylus as is well known in the art) as the input means, for example see Kadowaki. Thus, it would have been further obvious to one of ordinary skill in the art at the time the invention was made to modify the device of the obvious combination of Wert and Davis to comprise a touch pad as the input means since the touch pad is more versatile and provides more information selection input than the standard keypad.

Regarding claim 18, Davis also teaches to provide a printer to the videophone for a hardcopy printout of the transaction, see Davis col. 15 lines 27-45.

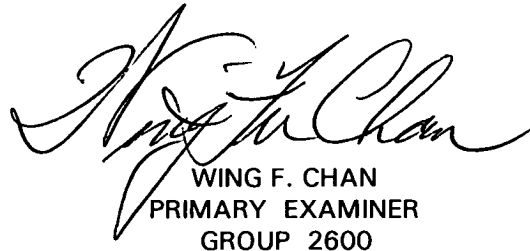
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner W. F. Chan** whose telephone number is (703) 305-4732.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4750.



WING F. CHAN
PRIMARY EXAMINER
GROUP 2600

WFC